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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,260	04/15/2004	Kwong-Onn C. Chan	V2003021	8121

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James E. Bradley
BRACEWELL & PATTERSON, LLP
P.O. Box 61389
Houston, TX 77208-1389

EXAMINER

BOMAR, THOMAS S

ART UNIT PAPER NUMBER

3672

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,260

Applicant(s)

CHAN ET AL.

Examiner

Shane Bomar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 43.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 6,289,992 to Monjure et al.

Regarding claim 1, Monjure et al disclose a method of pumping a fluid into a string of tubing suspended from a wellhead within casing in a well, comprising: (a)

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closing a lower end of an elastomeric hose 51 and pumping a fluid into the hose while the lower end of the hose is closed to create internal pressure in the hose to increase rigidity of the hose; (b) inserting the hose through a port 23 in a sidewall of the wellhead and causing the hose to deflect and move downward from the port into the tubing; and (c) increasing the internal pressure in the hose to a level sufficient to cause the lower end of the hose to open, and discharging the fluid into the tubing (see Figs. 1, 4, and 7; col. 3, lines 11-41; and col. 3, line 59 through col. 4, line 24).

Regarding claim 4, the method according to claim 1, further comprising continuing to push the hose downward in the tubing while discharging the fluid out the lower end of the hose (see col. 4, lines 11-12).

Regarding claim 5, the method according to claim 1, further comprising retrieving the hose after step (c) (see col. 3, lines 39-41).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monjure et al ('992) in view of Monjure et al ('239).

Regarding claim 2, '992 teaches the method of claim 1 that includes an elastomeric hose inserted into the wellhead. However, it is not expressly taught that an articulated weight bar is attached to the lower end of the hose.

'239 teaches a method similar to that of '992. It is further taught that an articulated weight bar is attached to the lower end of the hose 98 (see col. 3, lines 8-10). It would have been obvious to one of ordinary skill in the art, having the teachings of '992 and '239 before him at the time the invention was made, to modify the hose taught by '992 to include the weight bar of '239, in order to obtain assistance in installing the hose. One would have been motivated to make such a combination since both references address the narrow problem of inserting elastomeric hoses into the sidewall of a wellhead, therefore a person seeking to solve that exact problem would consult these references and apply their teachings together.

Regarding claim 8, the '239 reference can analogously be applied to the combination immediately below for the additional teaching of the weight bar.

7. Claims 3, 6, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monjure et al in view of US patent 6,352,113 to Neuroth and in view of US patent 5,154,588 to Freet et al.

Regarding claims 3, 6, and 10, Monjure et al teach the method similar to claim 1 of pumping a fluid that includes an elastomeric hose inserted through a port in the side of the wellhead and down into the well along a string of tubing. However, it is not explicitly taught that the well contains a pump at the end of the tubing 17, or that the string of tubing is rotated by a string of rods extending through the tubing to a motor assembly mounted to the wellhead; or further that step (b) comprises pushing the hose alongside the string of rods within the tubing for the purpose of cleaning debris from the pump components.

Neuroth teaches a method for cleaning debris away from a pump that is attached to the end of tubing 14 (see Figs. 1A and 1B). It would have been obvious to one of ordinary skill in the art, having the teachings of Monjure et al and Neuroth before him at the time the invention was made, to modify the tubing string taught by Monjure et al to include the pump at the end of the tubing string of Neuroth, in order to obtain an apparatus to pump downhole fluids to the surface. One would have been motivated to make such a combination because a) Neuroth has shown it to be notoriously known in the art to attach a pump to the end of tubing string for producing fluids, b) Monjure et al are silent as to how the fluids are to be produced from downhole to the surface through the tubular string, and c) Monjure et al's elastomeric hose would replace the tubular 62 to provide a retrievable means of cleaning debris from around the pump, without requiring the costly specially manufactured pump with the tubing 62 already attached, thereby allowing the use of more conventional, and possibly cheaper, equipment.

However, this combination does not explicitly teach that the string of tubing is rotated by a string of rods extending through the tubing to a motor assembly mounted to the wellhead, or that step (b) comprises pushing the hose alongside the string of rods within the tubing for the purpose of cleaning debris from the pump components.

Freet et al teach that rotary pumps operated by rotating a string of rods and electrical submersible pumps are notoriously known art equivalents (see col. 6, lines 21-24). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art that the pump attached to the end of the combination's string of tubing could also be a rotary pump with the aforementioned components.

Regarding claim 7, the combination applied to claim 6 above teaches that the desired depth would inherently be when the lower end of the hose ceases to move downward in the tubing, or else too much tubing would be unreeled and possibly lead to the hose becoming stuck and/or malfunction.

Regarding claim 9, the combination applied to claim 6 above teaches that step (e) comprises simultaneously discharging water out the closure member while pushing the hose downward (see col. 4, lines 11-12 of Monjure et al).

Conclusion

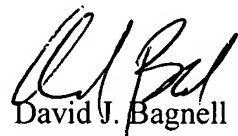
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Godare teaches a flexible tube 46 inserted in a port of a wellhead using a weight bar 40 at the end of the tube (see Figs. 1-3). Clark et al teach a flexible hose 37 used to clean away debris downhole (see Figs. 1 and 2).

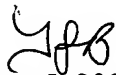
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb 
January 5, 2006